

39. The oral dosage form of claim 19, wherein the sustained release carrier causes said opioid antagonist to be released over a time period of about 12 hours when orally administered to a human patient.
40. The oral dosage form of claim 19, wherein the sustained release carrier causes said opioid antagonist to be released over a time period of about 24 hours when orally administered to a human patient.

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**REMARKS**

Reconsideration of the present application as amended is respectfully requested. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned **"Version With Markings To Show Changes Made."**

**I. Status of the Claims.**

Claims 1, 3, 6-32 and 34-40 are pending. Claims 1, 19, 20, 27 and 32 have been amended. Claims 37-40 have been added. Support for the amendments and new claims is found throughout the specification and in the claims as originally filed. It is respectfully submitted that no new matter has been added by virtue of this amendment.

**II. Rejections under 35 U.S.C. § 103(a)**

Claims 1, 3, 6, 8-10, 12-18, 21-26, 32, 34, and 36 were rejected under 35 U.S.C. 103(a) on the grounds of being obvious over the Crain reference in view of either the Hynes reference, the Raffa reference or the Dudzinski reference. Also, claim 7 was rejected on the grounds of being obvious over the preceding combination of references further in view of the Gauthier reference.

Claims 1, 3, 6, 8-10, 12-18, 21-26, 32, 34, and 36 were rejected under 35 U.S.C. 103(a) as being unpatentable over the Gordon reference in view of either the Hynes reference, the Raffa

reference, or the Dudzinski reference. Also, claim 7 was rejected on the grounds of being obvious over the preceding combination of references further in view of the Gauthier reference.

These rejections are now moot as claim 1 has been amended to recite the limitations of claim 11. This amendment is made in order to advance the prosecution of this application and without prejudice to pursuing the claims as recited prior to the present amendment in a continuation application

Claims 11, 19-20, 27-31 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Crain reference in view of either the Hynes reference, the Raffa reference, or the Dudzinski reference, further in view of the Oshlack reference. The Examiner states that the Crain, Hynes, Raffa and Dudzinski references do not teach controlled release formulations as required in the instant claims. The Examiner further states that the Oshlack reference “teaches controlled release opioid formulations that meet the instant claims”. The Examiner concludes that “it would have been obvious to one skilled in the art at the time of the invention to provide controlled release formulations of the obvious previous compositions to reduce the frequency of administration”.

This rejection is respectfully traversed. It is submitted that the claims are not obvious over the combination of the cited references, at the very least, as the Crain reference is not properly combinable with the Oshlack reference. Crain teaches at column 7, lines 1-2, that the combination described therein can be administered orally, sublingually, intramuscularly, subcutaneously or intravenously. Further, the methodology used in the examples of Crain are in-vitro tests wherein the drugs are applied by bath perfusion to DRG mice neurons. Crain does not contemplate controlled release oral dosage forms. In contrast, the Oshlack reference is directed to stabilized controlled release dosage forms and does not contemplate immediate release dosage forms. Accordingly, one skilled in the art would not be motivated to combine the Crain reference with the Oshlack reference. Claims 11, 19-20, 27-31 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordon et al (4,457,933; hereafter ‘933) in

combination with Hynes (EP 0 193 355; hereafter '355) and further in combination with Oshlack et al (5,472,712; hereafter '712) or Gordon et al ('933) in combination with Raffa et al (5,336,691; hereafter '691) and further in combination with Oshlack ('712) or Gordon et al ('933) in combination with Dudzinski ('140) and further in combination with Oshlack et al ('712).

This rejection is respectfully traversed. It is submitted that the claims are not obvious over the combination of the cited references, at the very least, as the Gordon reference is not properly combinable with the Oshlack reference. Gordon teaches at column 4, lines 8-12, that the combination described therein can be formulated as solid preparations suitable for oral administration such as tablets, capsules, powders, granules, emulsions and suspensions, as well as liquid preparations suitable for parenteral administration. Further, the in-vivo examples provided in Gordon was performed by subcutaneous injection to rhesus monkeys. Gordon does not contemplate controlled release oral dosage forms. In contrast, as discussed above, the Oshlack reference is directed to stabilized controlled release dosage forms and does not contemplate immediate release dosage forms. Accordingly, one skilled in the art would not be motivated to combine the Gordon reference with the Oshlack reference.

### **III. Double Patenting Rejection of Claims 1-36.**

In the Office Action, the Examiner provisionally rejected claims 1-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of U.S. Patent No. 6,277,384 and claims 1-36 of copending Application No. 09/503,020.

In response, it is submitted that Applicants will consider the filing of Terminal Disclaimers to obviate the double-patenting rejection upon an indication from the Examiner that the claims are otherwise allowable.

**IV. Conclusion**

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "**Version With Markings To Show Changes Made.**"

It is now believed that the above-referenced rejections and objections have been obviated and it is respectfully requested that the rejections and objections be withdrawn. It is believed that all claims are now in condition for allowance.

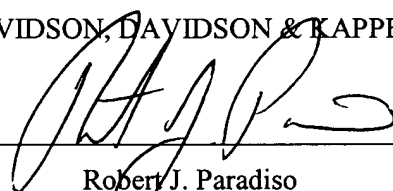
According to currently recommended Patent Office policy the Examiner is specifically authorized to contact the undersigned in the event that a telephonic interview will advance the prosecution of this application.

An early and favorable action is earnestly solicited.

Respectfully submitted,

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**Version With Markings To Show Changes Made****IN THE CLAIMS**

The following claim has been amended as follows:

1. (Amended) An oral dosage form, comprising:
  - (A) an opioid agonist;
  - (B) acetaminophen; [and]
  - (C) an opioid antagonist and
  - (D) a sustained release carrier which causes said opioid agonist to be released over a time period of about 8 to about 24 hours when orally administered to a human patient.
19. The oral dosage form of claim 1 [11], wherein the sustained release carrier further causes said opioid antagonist to be released over a time period of about 8 to about 24 hours when orally administered to a human patient.
20. The oral dosage form of claim 1 [19], wherein the sustained release carrier further causes the acetaminophen to be released over a time period of about 8 to about 24 hours when orally administered to a human patient.
27. The oral dosage form of claim 1, wherein said [further comprising a] sustained release carrier [which] causes said antagonist and said acetaminophen [the drugs] to be released over a time period of about 8 to about 24 hours when the dosage form is orally administered to a human patient.

32. A method of treating pain, comprising administering an oral dosage form which contains an opioid agonist and acetaminophen in amounts which render the dosage form analgesically effective when orally administered, the oral dosage form further including an opioid antagonist and a sustained release carrier which causes said opioid agonist to be released over a time period of about 8 to about 24 hours when orally administered to a human patient.